

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

SMA SOLAR TECHNOLOGY AG,

Plaintiff,

v.

**SMA ALLIANCE, INC., and
SMA ENERGY CORPORATION,**

Defendants.

CIVIL ACTION

Case No. _____

COMPLAINT

Plaintiff, SMA Solar Technology AG (“SMA Solar”), by and through its undersigned counsel, files this complaint against Defendants, SMA Alliance, Inc. (“SMA Alliance”) and SMA Energy Corporation (“SMA Energy”), and alleges as follows:

NATURE OF THE ACTION

1. This is an action for trademark infringement and unfair competition arising under the trademark laws of the United States, 15 U.S.C. §§ 1051 *et seq.*

THE PARTIES

2. Plaintiff SMA Solar is a German company with a principal place of business at Sonnenallee 1, 34266 Niestetal, Federal Republic of Germany.

3. Upon information and belief, Defendant SMA Alliance is a Delaware corporation having a place of business at 1830 Burlington Ave., Suite 401, Casper, Wyoming 82601.

4. Upon information and belief, Defendant SMA Energy is a Wyoming corporation having a place of business at 6011 S. Spruce Street, Casper, Wyoming 82601.

JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction of this action pursuant to 28 U.S.C. §§ 1331 and 1338, and 15 U.S.C. § 1121.

6. This Court has personal jurisdiction over Defendants because SMA Alliance is incorporated in this state, and SMA Alliance and its subsidiary SMA Energy do business in this state and this district, and because the actions described herein took place in this state and in this district.

7. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b) and (c) because the facts giving rise to the claims alleged herein occurred in this judicial district.

FACTS

8. SMA Solar is very well known throughout the world, including the United States, as the leading manufacturer of solar inverters and related products for solar energy installations. SMA Solar is headquartered in Niestetal, Germany, and it has manufacturing sites located in Germany, the United States, Canada, China, and South Africa.

9. SMA Solar has used the term **SMA** as a trademark, and as a component of its marks, in commerce in the United States since at least as early as September 26, 2000, on or in connection with *inter alia* solar, photovoltaic and energy generating systems; electrical transformers, electrical inverters; electrical measuring instruments; software; and related services.

10. On December 22, 2009, SMA Solar was granted U.S. Registration No. 3,728,531 by the United States Patent and Trademark Office for the **SMA** design mark shown below for use on the goods listed below:



Electrical measuring instruments, electrical controlling instruments, electrical regulating instruments and electrical analyzing instruments, each for electrical current flow in photovoltaic installations; transformers, inverters, electrical storage batteries, electrical controllers for solar power and wind turbines; computer hardware and peripherals as well as construction parts for microprocessors; optical display panel for monitoring the data of a solar plant or an inverter; computer software for the configuration of solar plants and the communication with inverters, computer evaluation software for inverters in photovoltaic installations; data loggers for collating and transmitting data of energy equipment, namely, photovoltaic installations (Class 9)

This registration is valid, subsisting, in full force and effect, and *incontestable*. A copy of the registration certificate is attached hereto as Composite Exhibit A.

11. On February 9, 2010, SMA Solar was granted U.S. Registration No. 3,747,043 by the United States Patent and Trademark Office for the word mark **SMA** for use on the following goods:

Electrical transformers, electrical inverters, electrical storage batteries; computer hardware and peripherals as well as construction parts for microprocessors; optical display devices, namely, displays for inverters in photovoltaic installations, computer evaluation software for inverters in photovoltaic installations; apparatus for collating and transmission of data from photovoltaic installations and railway engineering installations, namely, dataloggers (Class 9)

This registration is valid, subsisting, in full force and effect, and *incontestable*. A copy of the registration certificate is attached hereto as Composite Exhibit A.

12. On September 17, 2013, SMA Solar was granted U.S. Registration No. 4,402,197 by the United States Patent and Trademark Office for the **SMA** design mark shown below for use on goods listed below:



Electrical measuring instruments, namely, conductivity meters, voltage regulators for electric power; electrical controlling instruments, namely, electrical controllers, electrical fuses, safety switches, cutoff switches, switch boxes; electrical regulating instruments and electrical analyzing instruments, namely, meters and gauges for the analyzing of electricity; each for use in electricity generating systems as well as in high frequency technology and telecommunications; electrical transforming instruments, namely, electrical transformers, electrical inverters, electrical storage batteries, solar plants for generating consisting of solar modules, electric convertors, electric control instruments and electric battery storages (Class 9)

Instructional manuals and teaching materials in printed form in the field of solar technology and solar energy; writing instruments, namely, pencils and ball point pens; office requisites, namely, document files and notepads, brochures, prospectuses (Class 16)

Installation, repair and maintenance of solar photovoltaic and energy generating systems; maintenance, repair, replacement and tuning of components, parts and systems in solar, photovoltaic and energy generating systems; providing information concerning the installation, repair and maintenance works with respect to solar, photovoltaic and energy supply installations by means of a call center (Class 37)

Educational services, namely, providing classes, seminars and workshops in the field of solar technology; training in the field of solar technology (Class 41)

Technical consultancy in the technology field of devices and systems, for measuring, controlling, regulating and analyzing technique, especially for solar technique, for devices for conducting, switching, transforming, storing, regulating and controlling electricity, for energy supplying devices and systems as well as energy transformers for solar technique, for transformers, invertors, convertors, direct current convertors, accumulators as well as measuring and control devices therefore for solar plant systems for electricity, generations; technical monitoring, namely, inspection of solar photovoltaic and energy supply installations; technical consultancy in the technology field concerning solar, photovoltaic and energy supply installations (Class 42)

This registration is valid, subsisting, and in full force and effect. A copy of the registration certificate is attached hereto as Composite Exhibit A.

13. On October 22, 2013, SMA Solar was granted U.S. Registration No. 4,420,337 by the United States Patent and Trademark Office for the word mark **SMA** for use on the following goods:

Transportable buildings of metal for holding electric apparatus, in particular invertors (Class 6)

Devices and instruments for conducting, switching, transforming, storing, regulating and controlling electricity as well as devices and instruments for measuring and analyzing electricity, namely, electrical measuring instruments, electrical control instruments, electrical regulating instruments and electrical analyzing instruments, each for electrical current flow in electricity generating systems, e.g., and in photovoltaic installations; electrical measuring instruments, electrical controlling instruments, electrical regulating instruments and electrical analyzing instruments, in particular for high-frequency technology and telecommunications; electrical transformers, electrical invertors, electrical storage batteries; solar plants for generating energy consisting of solar modules, electric convertors, electric control instruments and electric battery storages; data processing apparatus, namely, computer hardware and computer software for monitoring, regulating and controlling data about electrical power generation and electrical power consumption (Class 9)

Instructional manuals and teaching materials in printed form in the field of solar technology and solar energy; writing instruments, namely, pencils and ball-point pens; office requisites, namely, document files and note pads (Class 16)

Transportable buildings of concrete for holding electric apparatus, in particular inverters (class 19)

Marketing services for third parties in the field of renewable energies designed to support the tradesman (Class 35)

Installation, repair and maintenance of solar, photovoltaic and energy generating systems; maintenance, repair, replacement and tuning of components, inns and systems in solar, photovoltaic and energy generating systems: providing information concerning the installation, repair and maintenance works with respect to solar, photovoltaic and energy supply installations by means of a call center (Class 37)

Provision of access to an Internet portal featuring marketing services of tradesmen in the field of renewable energy; provision of access to Internet portals and databases monitoring photovoltaic installations and operative data (Class 38)

Educational services, namely, providing classes, seminars and workshops in the field of solar technology; training in the field of solar technology (Class 41)

Technical consultancy in the technology field of devices and systems for measuring, controlling, regulating and analyzing technique, especially for solar technique, for devices for conducting, switching, transforming, storing, regulating and controlling electricity, for energy supplying devise and systems as well as energy transformers for solar technique, for inverters, converters, direct current converters, accumulators as well as measuring and control devices therefor, for solar plant systems for electricity generation; technical monitoring, namely, inspection of solar, photovoltaic and energy supply installations; technical consultancy in the technology field concerning solar, photovoltaic and energy supply installations (Class 42)

This registration is valid, subsisting, and in full force and effect. A copy of the registration certificate is attached hereto as Composite Exhibit A.

14. On May 26, 2015, SMA Solar was granted U.S. Registration No. 4,741,702 by the United States Patent and Trademark Office for the word mark **SMA** for use on the following goods:

Optical displays, namely, displays for inverters in photovoltaic units; downloadable computer software in the nature of a desktop, laptop or netbook application for communicating with inverters (Class 9)

Brochures and prospectuses in the field of solar energy (Class 16)

This registration is valid, subsisting, and in full force and effect. A copy of the registration certificate is attached hereto as Composite Exhibit A.

15. SMA Solar actively promotes its products and services offered under each of the registered marks noted above (hereinafter, the “**SMA Marks**”) throughout the United States, within the renewable energy industry, including via its website www.sma-america.com.

16. SMA Solar’s use of **SMA** as a trademark, and as a component of its marks, has been continuous and substantially exclusive for the past sixteen (16) years, and SMA Solar has developed significant goodwill in each of the **SMA Marks**. The products and services offered and sold under each of the **SMA Marks** are readily recognized and appreciated by customers and industry members, and they are some of SMA Solar’s most valuable assets.

17. Upon information and belief, prior to 2016, SMA Alliance was conducting business primarily within the automotive industry, and was not involved in the renewable energy industry. SMA Solar does not challenge SMA Alliance’s continued use of “SMA” in association with business activities outside the renewable energy industry.

18. Upon information and belief, in August of 2016, SMA Alliance launched a subsidiary called SMA Energy Corporation (“SMA Energy”), with SMA Energy’s business to be focused on products and services within the renewable energy industry. SMA Energy’s business activities are promoted via SMA Alliance’s website at www.smaalliance.net/energy. More particularly, SMA Energy recently introduced a solar and wind powered electrical bicycle, and SMA Energy has indicated its intention to introduce more revolutionary technologies within the renewable energy industry. Articles relating to SMA Alliance’s and SMA Energy’s activities within the renewable energy industry are attached hereto as Exhibit B.

19. In August 2016, SMA Solar sent written notice to SMA Alliance of SMA Solar’s concerns regarding the use of the term “SMA” as part of the “SMA Alliance” and “SMA Energy” trade names within the renewable energy industry. A copy of the letter is attached hereto as Exhibit C. By such written notice, SMA Solar put SMA Alliance on actual notice of the **SMA Marks** and SMA Solar’s prior use of the mark **SMA** on or in connection with products and services within the renewable energy industry. Neither SMA Alliance nor SMA Energy has responded to the written notice from SMA Solar.

20. On October 12, 2016, SMA Solar, via its attorneys, sent a letter to SMA Alliance to again express concerns regarding the use of the term “SMA” as part of the “SMA Alliance” and “SMA Energy” trade names within the renewable energy industry. A copy of the October 12, 2016 notice letter is attached hereto as Exhibit D. Neither SMA Alliance nor SMA Energy has responded to the written notice from SMA Solar’s attorneys.

COUNT I
Federal Trademark Infringement
15 U.S.C. § 1114

20. SMA Solar hereby repeats and incorporates the allegations contained in Paragraphs 1 through 19 as if fully set forth herein.
21. This claim is brought under 15 U.S.C. § 1114.
22. SMA Solar has continuously and extensively used the **SMA Marks** in the United States since at least as early as September 26, 2000, and has not abandoned any of the marks.
23. SMA Solar owns the federal trademark registrations for the **SMA Marks**, which registrations are valid, subsisting, and in full force and effect.
24. SMA Solar's use and registration of the **SMA Marks** in the United States for products and services within the renewable energy industry is prior to any date upon which SMA Alliance or SMA Energy could rely as the first date on which Defendants used the terms "SMA" or "SMA Alliance" or "SMA Energy" on Defendants' related products and services within the same industry.
25. Defendants' use of the term "SMA" as part of the "SMA Alliance" and "SMA Energy" trade names for use on and in connection with products and services offered within the renewable energy industry so resembles SMA Solar's prior used and registered **SMA Marks** for closely related products and services offered within the same industry that it is likely to confuse, mislead, and deceive members of the public into believing that SMA Solar has allowed, sponsored, approved, or licensed Defendants to provide competing products and services, or that Defendants are in some way connected to or affiliated with SMA Solar.
26. Any such confusion would result in injury or have a direct impact on SMA Solar's reputation and its ability to market its own products and services under the **SMA Marks**.

Furthermore, any defect, objection, or fault found with Defendants' products or services would negatively impact and seriously injure the reputation SMA Solar has established for the products it sells and services it offers under the **SMA Marks**.

27. Defendants' activities are being carried out willfully, with constructive and actual notice of SMA Solar's prior rights and registrations in and to the **SMA Marks**.

28. Defendants are liable for infringement of the federally registered **SMA Marks** in violation of 15 U.S.C. § 1114.

29. SMA Solar is entitled to recover damages in an amount to be determined at trial, including profits made by Defendants on their sales of infringing products and services, and the costs of this action; also, because Defendants' activities are willful, this is an exceptional case entitling SMA Solar to recover treble damages and reasonable attorneys' fees, pursuant to 15 U.S.C. § 1117(a).

30. SMA Solar has been and will continue to be irreparably injured by Defendants' conduct. SMA Solar cannot be adequately compensated for these injuries by monetary remedies alone, and SMA Solar has no adequate remedy at law for Defendants' infringement of its rights. SMA Solar is therefore entitled to injunctive relief against Defendants pursuant to 15 U.S.C. § 1116(a).

COUNT II
Unfair Competition
15 U.S.C. § 1125(a)

31. SMA Solar hereby repeats and incorporates the allegations contained in Paragraphs 1 through 30 as if fully set forth herein.

32. This claim is brought under 15 U.S.C. § 1125(a).

33. SMA Solar has continuously and extensively used the **SMA Marks** in the United States since as early as September 26, 2000, and has not abandoned any of the marks.

34. The **SMA Marks** are each distinctive, commercially strong, and are federally registered.

35. SMA Solar's use and registration of the **SMA Marks** in the United States for products and services within the renewable energy industry is prior to any date upon which Defendants could rely as the first date on which they used the terms "SMA" or "SMA Alliance" or "SMA Energy" on Defendants' related products and services within the renewable energy industry.

36. Defendants' use of the term "SMA" as part of the "SMA Alliance" and "SMA Energy" trade names for use on and in connection with products and services offered within the renewable energy industry so resembles SMA Solar's prior used and registered **SMA Marks** for closely related products offered within the same industry that it is likely to confuse, mislead, and deceive members of the public into believing that SMA Solar has allowed, sponsored, approved, or licensed Defendants to provide competing products and services, or in some way Defendants are connected to or affiliated with SMA Solar.

37. Any such confusion would result in injury or have a direct impact on SMA Solar's reputation and its ability to market its own products and services under the **SMA Marks**. Furthermore, any defect, objection, or fault found with Defendants' products or services would negatively impact and seriously injure the reputation SMA Solar has established for the products it sells and services it offers under the **SMA Marks**.

38. Defendants' activities are being carried out willfully, with constructive and actual notice of SMA Solar's prior rights and registrations in and to the **SMA Marks**.

39. Defendants are liable for unfair competition in violation of 15 U.S.C. § 1125(a).

40. SMA Solar is entitled to recover damages in an amount to be determined at trial, including profits made by Defendants on its sales of its infringing products and services, and the costs of this action; also, because Defendants' activities are willful, this is an exceptional case entitling SMA Solar to recover treble damages and reasonable attorneys' fees, pursuant to 15 U.S.C. § 1117(a).

41. SMA Solar has been and will continue to be irreparably injured by Defendants' conduct. SMA Solar cannot be adequately compensated for these injuries by monetary remedies alone, and SMA Solar has no adequate remedy at law for Defendants' infringement of its rights. SMA Solar is therefore entitled to injunctive relief against Defendants pursuant to 15 U.S.C. § 1116(a).

PRAYER FOR RELIEF

WHEREFORE, Plaintiff SMA Solar Technology AG respectfully prays for the following relief against Defendants SMA Alliance, Inc. and SMA Energy Corporation, as follows:

- (a) An order declaring that Defendants' unauthorized conduct violates the Lanham Act, 15 U.S.C. §§1114 and 1125;
- (b) An order permanently enjoining and restraining Defendants and those in active concert and participation with Defendants from:
 1. Further infringing, counterfeiting, and/or making any use of the **SMA Marks**, and any colorable imitations, to advertise, promote, display, sell, or offer any products and services within the renewable energy industry;
 2. Representing or suggesting to any third party that Defendants or their products or services are affiliated with, sponsored by, licensed by, or otherwise associated with SMA Solar and/or the **SMA Marks**; and
 3. Otherwise unfairly competing with SMA Solar;
- (c) An order directing any other relief that the Court may deem appropriate to prevent the public from deriving any erroneous impression that any products or services offered by Defendants are authorized by SMA Solar or are in any way related to SMA Solar or its products and services;
- (d) An order directing an accounting and judgment be rendered against Defendants for:
 1. All profits received by Defendants and all damages sustained by SMA Solar as a result of Defendants' infringement and/or unfair competition, relating to the use of the terms "SMA" or "SMA Alliance" "SMA Energy" for products and services in the renewable energy industry, as provided for in 15 U.S.C. § 1117; and

2. An award of treble damages to SMA Solar for Defendants' willful and deliberate conduct, pursuant to 15 U.S.C. § 1117; and
 3. An award to SMA Solar for costs, including reasonable attorneys' fees and disbursements in this action, pursuant to 15 U.S.C. §§ 1114 and 1117; and
- (e) Any other relief that the Court finds warranted and just.

Dated: January 4, 2017



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